

REMARKS

In the Office Action dated December 22, 2004, claims 1-33 were presented for examination. Claims 5 and 18 were considered as containing allowable subject matter, but were rejected based on a rejected base claim. Claims 1-4, 6-17, and 19-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Henderson et al.*, U.S. Patent No. 6,446,188, in view of *Gulick et al.*, U.S. Patent No. 6,314,501.

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application.

I. Objection to the Specification

In the Office Action of December 22, 2004, the Examiner objected to the Specification, and more specifically to a misspelled word at page 1, line 24. Applicants have amended the misspelled word. Accordingly, in view of the amendment to the paragraph containing the misspelled word, Applicants respectfully requests that the Examiner remove this objection to the Specification.

II. 35 U.S.C. §103(a) - unpatentable over *Henderson et al.* in view of *Gulick et al.*

In the Office Action of December 22, 2004, the Examiner rejected claims 1-4, 6-17, and 19-33 under 35 U.S.C. §102(b) as being unpatentable over *Henderson et al.* in view of *Gulick et al.*

Applicants hereby incorporate the comments to *Henderson et al.* and *Gulick et al.* made in the Response to the First Office Action.

As noted in the response to the First Office Action, *Henderson et al.* does not disclose utilizing platform firmware for dynamically routing between the virtual address and the physical address, and *Gulick et al.* does not disclose mapping of the virtual and physical addresses, as

claimed by Applicants. The Examiner uses *Gulick et al.* to support the proposition that the routing taught therein may be associated with firmware. However, the Examiner's claim that *Gulick et al.* provides motivation or suggestion that the routing taught therein may be utilized in firmware stems from the one instance where the term "firmware" is used in the entire 84 column, 78 page patent document. *Gulick et al.* does not even teach how their own routing system may be modified to be embedded within firmware, or why such an incorporation would benefit the invention of *Gulick et al.*.

Furthermore, not only does *Gulick et al.* provide only one mention of the term "firmware" without further elaboration or discussion, this single use of the term "firmware" is made in what is commonly referred to as the "spirit and scope" paragraph of a patent specification. This paragraph is utilized at the conclusion of a patent specification as a stylistic element that projects the overall scope of the technological area in which the patent specification resides. However, as is the case in *Gulick et al.*, a spirit and scope paragraph does not provide any substantive guidance as to how, why or when the claimed invention can or would be applied to their own invention. As a general matter, the spirit and scope paragraph is so broad and generic that it lacks teaching, suggestion or motivation of any embodiment beyond that taught by the patent specification in which it is placed.

Even if one were to input the firmware as stated in the spirit and scope clause into the invention of *Gulick et al.*, the modification still does not teach the dynamic mapping as claimed by Applicants. Absent Applicant's invention, there is no suggestion or motivation within the combination of *Henderson et al.* and *Gulick et al.* for such a modification. The Examiner is merely using hindsight reconstruction to apply the combination of *Henderson et al.* and *Gulick et al.* to Applicants' invention.

As noted by the Examiner in the Second Office Action, "Although *Gulick* does not disclose each and every limitation given by Applicant, *Gulick* provides the motivation of using the one limitation of utilizing firmware to implement address mapping." Second Office

Action, Page 3, Item 6. The Examiner claims to have found each of the elements claimed by Applicant, but has not found the motivation for applying the combination of the references to the mapping of Applicants. "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' " *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998), citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 38 USPQ 2d 1551 (Fed. Cir. 1996). Accordingly, Applicants reassert that the Examiner is improperly using hindsight reconstruction to negate patentability.

"To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the invention and with no knowledge of the claimed invention, would select elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*. The solitary mention of "firmware" in the length patent of *Gulick et al.* is provided in the well known boilerplate spirit and scope clause stating that modifications may be made to their disclosure and that these modifications remain limited to the scope of the associated specification. There is no specific teaching on how one of ordinary skill in the art would modify the invention of *Gulick et al.* into firmware, and as such one of ordinary skill in the art would not have found benefits for modifications espoused in the spirit and scope clause. It is improper for the Examiner to attempt to substitute "motivation" requirements needed to support a rejection on obviousness grounds with a conventional "spirit and scope clause" in an issued patent, especially when the Examiner attempts to apply the specific wording of the clause beyond the scope of the issued patent. To apply firmware to dynamically route virtual and physical resource address is complex, and is certainly not trivial. There is no teaching in *Gulick et al.* as to how the invention disclosed therein would be modified to support the use of

firmware, and even if it did, such modification would not apply to the mapping as claimed by Applicants. Applicants use of platform firmware to support dynamic routing of a virtual resource address and physical resource addresses and the "modifications" the Examiner is reading into *Gulick et al.* would require altering the very structure, use, and application of the invention, the *Gulick et al.* language still fails to read on or motivate Applicants' invention. Accordingly, Applicants respectfully contend that the combination of *Henderson et al.* and *Gulick et al.* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests allowance of claims 1-4, 6-17, and 19-33.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,



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The transmission ends with this page